



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,653	06/26/2000	Yong Zou	8737-000007	8304

7590 08/04/2003

Harness Dickey & Pierce
PO Box 828
Bloomfield Hills, MI 48303

EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/529,653

Applicant(s)

ZOU ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-19-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,6,7,9,11,12,14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,6,7,9,14,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 6-7, 14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 8266261 - Derwent Abstract.

The Derwent Abstract of JP 8266261 discloses a cigarette having a main body and a filter attached integrally to an end of the main body, said filter comprising dried and crushed ginkgo leaves. By providing a cigarette filter formed of ginkgo leaves, a cigarette comprising a burnable material is obviously provided because the "filter" is a part of the cigarette of the Abstract of JP 8266261, and ginkgo leaves are obviously "burnable", since it is a plant material and since almost any material is "burnable" if subjected to high enough temperatures. Therefore, ginkgo leaves as used in the filter of the cigarette of the Abstract of JP 8266261 qualifies as "burnable material". Further, since "ginkgo leaves" qualifies as such a burnable material, the step of smoking a cigarette comprising leaves of ginkgo biloba, as recited in claims 14, 17 and 18, has also been satisfied.

Regarding claims 6-7 and 17 and 18, since the JP reference indicates that any of the listed herbs can be used as filtering agents in its disclosed filter, it follows that one

Art Unit: 1731

having ordinary skill in the art could have elected for said filter to comprise from 50-100% ginkgo leaves.

Applicant has added language reciting "wherein the burnable material burns during smoking"; however, this function is deemed to be inherent. As stated in MPEP 2112.01, in product claims, when the structure cited in the reference is substantially identical to that of the claims, a prima facie case of either anticipation or obviousness exists. In this case, the JP reference meets the structural limitations of the claim in that it suggests a cigarette material comprising a burnable material, said material being ginkgo biloba leaves.

3. Claims 4, 9, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over CN 1140036 - Abstract.

The CN 1140036 - Abstract discloses a toxicity-reduced cigarette that contains liquid having components of ginkgo leaf sprayed onto the smokable material of the cigarette (see English abstract). While CN 1140036 - Abstract may not state that the ginkgo leaves are burnable material or burn during smoking, it follows that the ginkgo leaves burn while smoking since said leaves are sprayed onto the material that is smoked/burned while the cigarette is in use.

Regarding claim 9, while CN 1140036 - Abstract may not state that the smokable material of its invention may be suitable for use in a cigar, it would have been obvious to one having ordinary skill in the art at the time of the invention to use the ginkgo-leaves-sprayed material for such purpose in order to reduce the damage of

Art Unit: 1731

nicotine that also would arise from smoking a cigar which, as is well-known, also comprises tobacco which would contain nicotine when smoked by a user.

Allowable Subject Matter

4. Claims 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments filed May 19th, 2003 have been fully considered but they are not persuasive.

- Regarding the JP 8266261 reference, Applicant argues that the Gingko material in the filter does not burn during smoking, and such leaves are not required to be present in the burnable portion of the cigarette.

Firstly, the recitation "the burnable material burns during smoking" recites a function, or a method, limitation. Applicant is reminded that claims directed to an article must be distinguished from the prior art in terms of its structure or physical characteristics rather than *function*. And, if a reference recites an article having similar/same characteristic, the function is deemed to be inherent. As stated in the above-rejection, the JP 8266261 reference discloses a cigarette having a burnable material, since ginkgo biloba is located in the filter portion of the cigarette, and such material "burns" – as does almost any substance at high enough temperatures.

Applicant has chosen to define the claims with language that does not further limit the

Art Unit: 1731

claims in terms of physical characteristics; therefore, this limitation does not patentably distinguish the claims from the JP '261 reference.

- Regarding CN 1140036, Applicant argues that this reference describes a liquid extract of Ginkgo leaves being sprayed on tobacco, and that such reference does not, hence, disclose a smoking article with a burnable portion made of Ginkgo leaves. However, the Examiner contends that the use of the CN 140036 reference is still proper since a reading of one of the English translations of this reference, i.e Derwent, indicates that a liquid having "components of ginkgo leaf" is sprayed onto the tobacco. One having ordinary skill in the art, after reading the Derwent translation, would not have necessarily concluded that this liquid was an extract of Ginkgo leaves. One could have reasonably concluded that this liquid, in fact, contained ginkgo leaves.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

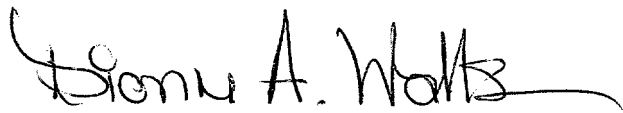
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink that reads "Dionne A. Walls". The signature is stylized with a large, sweeping initial 'D' and a long horizontal line extending from the end of the name.

Dionne A. Walls
August 3, 2003